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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

09/600,320

07/16/2000

John Peter Gahan

1223-001

1490

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7590

03/31/2004

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EXAMINER

TRIEU, THAI BA

ART UNIT

PAPER NUMBER

3748

DATE MAILED: 03/31/2004

*24*

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/600,320

Applicant(s)

GAHAN, JOHN PETER

Examiner

Thai-Ba Trieu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on February 13, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This Office Action is in response to the Amendment filed on February 13, 2004.  
Claims 16-30 were cancelled, and Claims 31-49 were added.

#### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

#### ***Oath/Declaration***

This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. ***The new claim 31 is broader than either the original claim 16 in the Amendment filed on September 17, 2003; or the original claim 1 in the application filed on July 06, 2000.*** A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Applicant deleted the following limitations in the claim 31:

1. said crankshaft and the cylinder block rotate in the same direction.

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2. an automatically rotatably transfer timing ring.
3. said engine housing having peripheral pivoted air vents for an automatically variable airflow.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the ***“pivot point”*** and ***“remote actuators”*** must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 31-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains new subject matter, which was not described in the specification in such a way as to reasonably

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convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

1. Specifically, claim 31 recites the limitation of ***“the piston members supported upon the crankshaft for a linear motion within the cylinder block as the crankshaft and the cylinder block rotate”***, which does not have any support in the original specification.

However, the above limitation is contradicted to what the applicant discloses Page 2, lines 3-4. The applicant discloses:

*“the piston members rotatably supported on said crankshaft for a rotary motion within the cylinder block as the crankshaft and the cylinder block rotate”*.

2. The new Claim 48 recites the limitations of ***“the plate pivotable about the pivot point”*** and ***“linear actuators connected to the plate”***, which does not have any support in the original specification.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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***Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gahan (Patent Number WO 93/11343), in view of Farris (Patent Number 4,038,949).***

Gahan discloses a two-stroke motor of the rotary piston type comprising:

- an engine housing (111);

- a cylinder block (114) rotatably mounted in the engine housing (111) for rotation relative thereto;

- a plurality of cylinders housed within the cylinder block (114);

- a plurality of piston members (115), each member respectively within associated with each cylinder (9);

- a crankshaft (113) indirectly geared to the cylinder block (114), the crankshaft (113) journaled for a rotation within the housing (111);

- slidably mounted circular rings for sealing the cylinder block against the engine housing (111); and

- at least one induction timing ring (20) operatively against to the engine housing (111) (See Figures 12-13, Page 2, lines 2-11, Page 7, lines 18-25, Page 10, lines 10-19, Page 14, lines 21-27, Page 15, lines 1-26, Page 19, lines 14-19, and Page 20, lines 1-23);

- wherein epicyclic gears (117) are provided to indirectly gear the cylinder block to the crankshaft by a ratio of 2:1 (See Page 2, lines 17-22, Page 7, lines 26-27, Page 8, lines 6-8, and Page 12, lines 14-18); and

wherein the cylinder block and crankshaft rotate in the same direction relative to the engine housing (See Page 2, lines 2-11, Page 7, lines 18-25, Page 10, lines 10-19).

However, Gahan fails to disclose an automatically rotatable induction timing ring, and the piston members supported upon the crankshaft for a linear motion within the cylinder block as the crankshaft and the cylinder block rotate.

Farris teach that it is conventional in the rotary radial internal combustion engine art, to utilize an automatically rotatable induction timing ring (164); the piston members (140, 141) supported upon the crankshaft (149) for a linear motion within the cylinder block as the crankshaft (149) and the cylinder block (138) rotate (See Figure 10, and Column 10, lines 51-62).

It would have been obvious to one having ordinary skill in the art at that time the invention was made, to have utilized an automatically rotatable induction timing ring; and the piston members supported upon the crankshaft for a linear motion within the cylinder block as the crankshaft and the cylinder block rotate, as taught by Farris, to improve the efficiency of the Gahan engine, since the use thereof would have controlled the gas flow to the engine.

### ***Response to Arguments***

Applicant's arguments with respect to claims 31-49 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Billings (US Patent Number 4,062,330) discloses a rotary engine intake and exhaust system.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action. (7.40)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai-Ba Trieu whose telephone number is (703) 308-6450. The examiner can normally be reached on Monday - Thursday (6:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on (703) 308-2623. The fax phone





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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTB  
March 29, 2004

  
Thai-Ba Trieu  
Patent Examiner  
Art Unit 3748

  
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TECHNOLOGY CENTER 3700